REMARKS

The above amendment and these remarks are responsive to the Office Action of Examiner Eric T. Shaffer mailed 07/02/2003.

Independent claims 1, 6, 7, 8, and 9 have been amended to more distinctly set forth an important feature of the present invention, to wit, the demanufacturing of an electronic product to recover the largest revenue possible, and determining if the electronic product contains any hazardous materials, and if so, determining a hazardous materials handling expense. Dependent claims 2 and 10 have been amended to include storage of the hazardous materials handling expense in a database. Entry of this amendment is respectfully requested.

Claims 1, 2, and 5-10 are in the case, none having been allowed.

INTERVIEW SUMMARY

Applicants' representative expresses appreciation for the courtesy extended by Examiner Eric T. Shaffer in the telephonic interview conducted on 09/30/2003.

The interview focused on approaches to amending the instant application so as to claim allowable subject matter. During this interview, Examiner Shaffer suggested that applicants' claims be amended so as to limit the claims to demanufacturing electronic products, and to also include determining if the electronic product contains any hazardous materials, and if so, determining

a hazardous materials handling expense. Applicants' claims have been amended in accordance with Examiner Shaffer's suggestions.

CLAIM OBJECTIONS

Claims 1 and 6-9 have been objected to because applicants' use of the term "greatest economic benefit by recovering largest revenue" is considered to be vague and indefinite, and that this term fails to consider that if the cost to recover a part exceeds the revenue generated from selling said part, then said part will be recovered at a loss, thus producing no profit and no economic benefit. Applicants have corrected this informality by amending claims 1 and 6-9 to include "said highest removed parts value less said labor expense".

35 U.S.C. § 103

Claims 1, 2, and 5-10 have been rejected under 35 USC 103(a) as being unpatentable over Suzuki et al. (US 5,965,858) in view of Graff (US 5,802,501).

Graff discloses a method for decomposing property into separately valued components that will "maximize profitability of the components" (column 6, lines 25-27). However, the property and components described in Graff are exclusively in the domain of real estate, and not electronic products. Graff considers such factors as cash flow, interest rates, terms of financing, taxes, risk, etc., and uses financial instruments such as estates and trusts to maximize the profitability of separately valued real estate components.

Accordingly, Graff is not in the field of applicants' endeavor, nor is Graff pertinent to the problem solved by applicants' claimed invention, to wit, demanufacturing an electronic product to recover the largest revenue possible. Furthermore, a routineer in the art of electronic product demanufacturing could not be reasonably expected to consider a document which provides teachings exclusively in the domain of real estate when conceiving of the instant invention.

Graff is therefore nonanalogous art, and its removal from further consideration as a reference is respectfully requested pursuant to MPEP 2141.01(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Suzuki et al. alone does not disclose all of applicants' steps of: providing an electronic product for demanufacturing, said electronic product having a plurality of parts, wherein each of said parts comprises one or more commodities, collecting one or more resale prices for one or more of said parts respectively, collecting one or more commodity prices for one or more of said commodities respectively, determining if said electronic product contains hazardous materials, and if so, determining a hazardous materials handling expense, determining a labor expense to remove said each of said parts from said electronic product, entering said one or more resale prices, said one or more commodity prices, said labor expense, and said hazardous materials handling expense, if any, into a computer or spreadsheet model, executing said computer or spreadsheet model to determine a highest

commodity value irrespective of said one or more resale prices for one or more of said parts, executing said computer or spreadsheet model to determine a highest removed parts value irrespective of said one or more commodity prices for one or more of said commodities, and executing said computer or spreadsheet model to optimally determine whether said highest removed parts value less said labor expense or said highest commodity value is greater and which of said parts, if any, to remove from said electronic product so as to recover said largest revenue as required by applicants' amended independent claims 1, 6, 7, 8, and 9.

Specifically, nowhere does Suzuki et al. disclose executing a computer or spreadsheet model to optimally determine whether said highest removed parts value less said labor expense or said highest commodity value is greater and which of said parts, if any, to remove from said electronic product so as to recover said largest revenue as required by applicants' amended independent claims 1, 6, 7, 8, and 9.

Accordingly, inasmuch as Graff is nonanalogous art and Suzuki et al. does not teach or suggest all of the steps, elements, or limitations required by applicants' amended claims as is required in a 35 U.S.C. 103(a) rejection pursuant to MPEP 2143.03, it is respectfully requested that the Examiner withdraw the rejection of applicants' amended independent claims 1, 6, 7, 8, and 9 under 35 U.S.C. 103(a), and allow claims 1, 6, 7, 8, and 9. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (emphasis added) Also, "All words in a claim must be considered in judging the patentability of that claim against the prior

art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Furthermore, claims 2 and 5 depend from allowable claim 1, and claim 10 depends from allowable claim 9. Claims 2, 5, and 10 are therefore also allowable. Pursuant to MPEP 2143.03, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, it is respectfully requested that the Examiner withdraw the rejection of applicants' dependent claims 2, 5, and 10 under 35 U.S.C. 103(a), and allow claims 2, 5, and 10.

The Application is deemed in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.02(j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Respectfully Submitted,

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